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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,020	06/10/2002	Rainer Blum	P 290586	7773

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT PAPER NUMBER

1712

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,020

Applicant(s)

BLUM ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-37 is/are pending in the application.
- 4a) Of the above claim(s) 22-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-33 is/are rejected.
- 7) ☒ Claim(s) 34-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims 22-27 drawn to an invention nonelected with traverse in Paper No. 112003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 28-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 and 12 of U.S. Patent No. 6,787,581. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 12 of the '581 patent sets forth a method of coating a substrate surface that comprises applying a powder composition that corresponds to the composition used in claim 28 of the instant application. The difference between the claims of '581 and claim 28 of the instant application is that the

composition of the instant claims is melted prior to application to the substrate whereas the composition of the '581 patent is applied prior to melting. It would have been obvious to one of ordinary skill in the art at the time of the invention to melt the composition prior to application to the substrate. See Ex parte Rubin 128 USPQ 440 (Bd. App. 1959), In re Burhans 154 F.2d 690, 69 USPQ 330 (CCPA 1946), In re Gibson 39 F.2d 975, 5 USPQ 230 (CCPA 1930). MPEP 2144.04 [R-1] (IV)(C).

Response to Arguments

4. Applicant's arguments filed 1/11/06 have been fully considered but they are not persuasive. Regarding the double patenting rejection, applicant argues that the patentable feature of the Blum et al. patent is the formulation of the powder coating material. Applicant argues that there is no teaching for changing the way the coating is applied. Applicant additionally argues that it would not have been obvious to change the known method because powder coatings cannot normally be worked in a different manner. Applicant argues that if the coating were to be melted before the application it would not be useable in conventional application systems since these systems cannot handle melted or molten coating compositions. Applicant also argues that it was accepted in the prior art that the step of melting after applying the coating to the substrate is crucial relative to powder handling because only then is a uniform coating of the substrate possible. Last, applicant argues that any other conclusion would be based on hindsight reconstruction.

In response, the examiner disagrees. First, regarding applicant's argument that the patentable feature of the Blum patent is the formulation of the coating application, it

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is noted that applicant is claiming the use of the same composition in the present claims. In response to applicant's argument that there is no teaching for changing the way the coating is applied, the examiner's position is that in the absence of new and unexpected results, it would have been obvious to one of ordinary skill in the art to change the steps in accordance with the case law cited above. In this respect, the examiner has not used hindsight to establish the obviousness argument. Also, in response to applicant's argument that if the powder coating were melted before application, conventional application systems could not be used, the examiner disagrees. The application of hot melt compositions to substrates is well known, and one of ordinary skill would have used a suitable technique to apply the molten coating composition. In response to applicant's argument that melting is crucial prior to application, the examiner does not find this argument persuasive as applicant has provided no evidence of this and in view of the instant specification, page 17, lines 20-23, which states that the hot melt compositions are granulated prior to use. If applicant's argument were true, the compositions of the present application would not be capable of forming uniform coatings since the constituents of the compositions of the Blum reference and the instant claims are the same and applicant's compositions appear to be in powder form before they are melted. Therefore, the double patenting rejection set forth above has been continued.

Allowable Subject Matter

5. Claims 34-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR